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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,255	06/07/2000	Charles J. Link JR.	P04091US1	8671

22885 7590 06/03/2004
MCKEE, VOORHEES & SEASE, P.L.C.
801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

WEHBE, ANNE MARIE SABRINA

ART UNIT PAPER NUMBER

1632

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,255

Applicant(s)

LINK

Examiner

Anne Marie S. Wehbe

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-27,29,31-33 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-27,29,31-33 and 35-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/23/04 has been entered. As requested the applicant's arguments and the declaration under 37 CFR 1.131 filed on 1/16/04 have been considered. As noted in the advisory action, the amendments to the claims filed on 1/16/04 have been entered. Claims 19-27, 29, 31-33, and 35-39 are currently pending and under examination in the instant application. An action on the merits follows.

Those sections of Title 35, US code, not included in this action can be found in previous office actions.

Claim Rejections - 35 USC § 102

The rejection of claims 19-27, 29, 31-33, and 35-39 under 35 U.S.C. 102(a) over Klatzmann et al. is withdrawn in view of applicant's submission of the declaration under 37 CFR 1.131 which establishes the applicant's invention of the claimed subject matter prior to November of 1998.

Art Unit: 1632

The claims as amended are subject to new grounds of rejection under 35 U.S.C. 102.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-27, 29, 31-33, and 35-39 rejected under 35 U.S.C. 102(b) as being anticipated by Link et al. (1996) Human Gene Therapy, Vol. 7, 1161-1179. As amended, the claims recite methods for treating a tumor in a human subject comprising administering to the subject near the tumor an effective amount of xenogeneic cells having α -(1,3) galactosyl epitopes to activate a hyperacute rejection, thereby treating said tumor. The claims further recite wherein the xenogeneic cells are murine vector producing cells, wherein the tumor is an ovarian or peritoneal carcinoma, and wherein the cells are injected into the peritoneal cavity.

Link et al. teaches the injection of murine HSVtk vector producer cells (VPCs) into the peritoneal cavity to treat ovarian cancer (Link et al., page 1162 in particular). Link et al. states that the introduction of murine HSVtk VPCs “induces a bystander effect and an anti-tumor immune response” (Link et al., page 1162, column 2, paragraph 1). While Link et al. does not explicitly teach that the murine VPCs have α -(1,3) galactosyl epitopes, it is an inherent and known property of all murine cells derived from wild type mice that they express α -(1,3) galactosyl epitopes.

Art Unit: 1632

Regarding the recitation in the claims that the administration of murine VPCs results in the activation of hyperacute rejection and innocent bystander response against the tumor, please note that Link et al. teaches the exact same methods steps as recited in the claims. The applicant is reminded that merely discovering and claiming a new benefit to an old process cannot render the process again patentable. *In re Woodruff*, 919 F. 2d 1575, 1577-78, 16 USPQ2d 1934, 1936-37 (Fed.Cir. 1990); *In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971); and *Ex Parte Novitski*, 26 USPQ2d 1389, 1391 (Bd. Pat. App. & Int. 1993). The MPEP also states that "when the claim recites using an old composition or structure and the 'use' is directed to a result or property of that composition or structure, then the claim is anticipated. *In re May*, 574 F. 2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978)" MPEP 2112.02. Link et al. teaches the same structure recited in the claims, murine VPCs which express α -(1,3) galactosyl epitopes, and further teaches the exact same method of administering these murine VPCs to treat tumors in humans. Thus, by teaching the same compositions and method steps as the instant claims as written, Link et al. anticipates the instant invention as claimed.

No claims are allowed.

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (703) 306-9156. The examiner can be reached Monday-Friday from 10:30-7:00. If the examiner is not available, the examiner's supervisor, Deborah Reynolds, can be reached at (703) 305-4051. General inquiries should be directed to the group receptionist whose phone number is (703) 308-0196. The technology center

Application/Control Number: 09/589,255

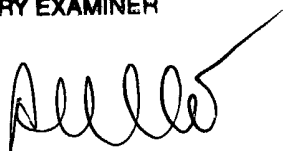
Page 5

Art Unit: 1632

fax number is (703) 872-9306. Please note that Official papers can no longer be received by the examiner's direct Rightfax number.

Dr. A.M.S. Wehbé

ANNE M. WEHBE' PH.D
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Anne M. Wehbé', with a long, sweeping horizontal line extending to the right.